

REMARKS

With respect to paragraph 1 of the Office Action, the inventors were employees of Champion Laboratories, Inc. at the time the invention was made and each is currently an employee of Champion Laboratories, Inc. This application was assigned to Champion Laboratories, Inc. and the Assignment was recorded in the Patent and Trademark Office on April 12, 2006 at Reel 015199, Frame 0585.

Claims 1-7 and 9-16 stand rejected as being unpatentable over Tarrant in view of Holyoak. Claim 8 stands rejected as being unpatentable over Tarrant in view of Holyoak and further in view of Decker.

Applicants submit as an attachment to this Amendment, a Declaration of Prior Invention in the United States Overcome Cited Patent Publication (37 C.F.R. § 1.131) to establish that the invention of this application was made (conceived and successfully, reduced to practice) prior to the effective date of the Tarrant publication, i.e., September 22, 2003 and thereby effectively remove Tarrant as a reference.

Considering the Declaration, document a, there is shown in the drawing captioned Bypass Filter With Zinc Co-Pleat a fluid filter having a shell which is closed at one end (not shown, but obvious to a person skilled in the art), and open at the other end. An end plate having openings closes the open end. A filter media is retained in the shell. The filter media comprises a pleated paper pack with zinc wrap. The paper is a cellulosic material. The purpose of the zinc wrap (or zinc layer) is to neutralize corrosive products in the fluid system (oil). In use, fluid will enter the shell via the inlet openings in end plate, pass through the filter media and exit the shell from the central outlet opening.

Document c shows the oil filter of the Assignee that was tested by an independent

research facility, i.e., Southwest Research Institute. The Southwest Research Institute Final Letter Report, document b, outlines the tests performed and the successful results achieved. Southwest Research Institute made a laboratory feasibility study, a test bench study and a comparison between a full-flow filter and a full-flow / bypass oil filter assembly. The Southwest Research Institute Final Letter Report concluded on page 8 that a full-flow / bypass oil filter (see document c.) containing louvered zinc mesh improved soot-removal efficiency by approximately 10-14 % and extended oil-drain interval by approximately 75%.

The evidence clearly demonstrates that the invention of the present application was made before the effective date of the Tarrant publication. The Tarrant publication should therefore be withdrawn as prior art *vis a vis* the subject matter of the present application.

Neither Holyoak or Decker suggest use in a fluid filter of a filter media that includes a metal that sacrificially neutralizes the corrosive products in the fluid. Neither Holyoak or Decker suggest that the metal be zinc. Neither Holyoak or Decker suggest co-pleating a zinc layer and a cellulosic layer. Applicants submit that the claims define patentable subject matter over Holyoak and Decker, taken individually or in combination. Claims 1-16 should now be allowed.

In conclusion, in view of the attached Declaration, the Tarrant publication should be withdrawn as prior art. The claims patentably distinguish over Holyoak and Decker and should be allowed.

Favorable reconsideration and allowance of this application are solicited.

Respectfully submitted,

Date: August 23, 2006

By: Seymour Rothstein
Seymour Rothstein
(Reg. No. 19,369)

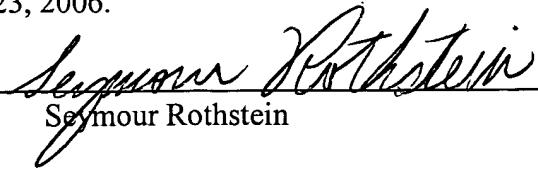


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OLSON & HIERL, LTD.
20 North Wacker Drive, 36th Floor
Chicago, IL 60606
(312) 580-1180

CERTIFICATE OF MAILING

I hereby certify that this paper and its attachments are being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 23, 2006.



Seymour Rothstein